



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/455,807	12/07/1999	John Beezer	3797.84618	5593

28319 7590 04/09/2003

BANNER & WITCOFF LTD.,  
ATTORNEYS FOR MICROSOFT  
1001 G STREET, N.W.  
ELEVENTH STREET  
WASHINGTON, DC 20001-4597

EXAMINER

SAX, STEVEN PAUL

ART UNIT	PAPER NUMBER
----------	--------------

2174

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No. 09/455807	Applicant(s) Beezer et al
Examiner Sax	Group Art Unit 2174

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- 11/21/03
- ☒ Responsive to communication(s) filed on \_\_\_\_\_.
  - ☒ This action is **FINAL**.
  - ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 1-30
- ☒ Claim(s) \_\_\_\_\_ is/are pending in the application.
  - ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
  - ☐ Claim(s) \_\_\_\_\_ is/are allowed.
  - ☒ Claim(s) \_\_\_\_\_ is/are rejected.
  - ☐ Claim(s) \_\_\_\_\_ is/are objected to.
  - ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 2174

### DETAILED ACTION

1. This application has been examined. The amendment filed 1/21/02 has been entered.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 1-6, 13-18, 25, 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Rivette et al (6389434).
4. Regarding claim 1, Rivette et al show a computer implemented method for annotating a system (abstract, Figures 6a, 7a-b, 20, column 4 lines 1-10). The system has a display for displaying an immutable (non-modifiable) page of a document having objects (column 10 lines 17-25, column 9 lines 27-40). The system receives an indication that an object is to be annotated in the page of the document (column 11 lines 10-20, Figures 15, 16, 17, column 12 lines 45-50),

Art Unit: 2174

and provides a window to the user having a portion for receiving the annotation of the object and a portion for allowing navigation to another object annotation (column 11 lines 33-38, 43-48, 55-65, column 12 lines 43-68, column 13 lines 29-35).

5. Regarding claim 2, the system receives a selection of the object and a menu item is selected to provide the window (for example Figures 9, 16, column 14 lines 15-24).

6. Regarding claim 3, the system receives user input and displays another annotation (column 13 lines 10-15).

7. Regarding claim 4, the non modifiable document page is maintained irrespective of the annotation display (column 15 lines 15-26).

8. Regarding claims 5-6, multiple annotations may be made, in which then multiple non modifiable pages are displayed which may overlie (column 11 lines 25-50, Figure 30, 31b, 32, column 15 lines 35-47, column 17 lines 14-24).

9. Claims 13-18 have the same features as above and are rejected for the same reasons.

Art Unit: 2174

10. Regarding claim 25, in addition to the aforementioned, note the storage device (column 9 lines 58-68) which implicitly determines the file position of the object I order to access it (column 10 lines 1-7).

11. Regarding claim 28, in addition to the reasons given for claim 25, note also the data fields (column 19 lines 30-60).

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 7-12, 19-24, 26-27, 29-30 rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al (6389434).

14. Regarding claim 7, in addition to the aforementioned, Rivette et al do not specifically mention displaying an indication that the text annotation has been stored in conjunction with an object on the non modifiable page, but as shown above the annotation is displayed in conjunction with an object on the page. The system also has storage capabilities and furthermore retrieves

Art Unit: 2174

and loads annotations (column 12 lines 60-68 and column 13 lines 1-16) in an organized way. It would have been obvious to a person with ordinary skill in the art to store the annotation with the object on the page, because it would provide a convenient way to later retrieve and load the annotations in an organized way.

15. Regarding claim 8, the position of the object is determined (Figures 7a, 8, 9, 10). It would have been obvious to a person with ordinary skill in the art to store the position and annotation in a separate area from the document, because it would provide a convenient way to later retrieve the information in an organized way.

16. Regarding claims 9 and 10, note the stylus and mouse (column 10 lines 28-32, column 14 lines 30-38).

17. Regarding claims 11 and 12, in addition to the aforementioned, it would have been obvious to a person with ordinary skill in the art to count bytes to determine the position of the object, because it would provide a thorough way to track a position for later retrieval. This may be accomplished by counting bytes from the beginning of the page to the annotation, using another object as a middle point.

Art Unit: 2174

18. Claims 19-24, 26-27, 29-30 show the same features as above and are rejected for the same reasons. In addition, it would have been obvious to a person with ordinary skill in the art to store the annotation and position in a modifiable portion of the document, because it would provide convenient retrieval to mutually modifiable portions.

19. Applicant's arguments filed have been fully considered but they are not persuasive. The sub note portion does allow navigation, as is acknowledged by applicant. Note that the common data object serves as a point of navigation. The annotation is in fact in the page of the document in Rivette. Regarding the file position, note that the claims are broad and the file position is in fact stored by Rivette in order to later retrieve it. If applicant means anything further, this must be in the claims.

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

Art Unit: 2174

will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

21. Any inquiry concerning this communication should be directed to Steve Sax at telephone number (703) 305-9582.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Sax whose telephone number is (703) 305-9582. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached on (703) 308-0640.

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703) 746-7238	After Final Communication
(703) 746-7239	Official Communication
(703) 746-7420	For Status Inquiries, draft communication

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

**STEVEN SAX**  
**PRIMARY EXAMINER**